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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,094	07/01/2003	Isaac Weiser	03-11987	5817
25189	7590	06/23/2005	EXAMINER	
CISLO & THOMAS, LLP 233 WILSHIRE BLVD SUITE 900 SANTA MONICA, CA 90401-1211			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/612,094

Applicant(s)

WEISER ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Restriction

Claims 1-3 and 12-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the reply filed on November 1, 2004.

Drawings

The drawings were received on April 14, 2005. These drawings are acceptable.

Claim Objections

Claim 4 is objected to because of the following informalities:

regarding claim 4, the limitation "one or more appendages corresponding to said plurality of apertures" in line 3 is grammatically incorrect as the examiner questions how

does one appendage correspond to the plurality of apertures when read in the alternative. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, lines 8-9 makes unclear where the appendages are secured.

Regarding claim 11, the claim depends from claim 10 and therefore is indefinite.

Claim Rejections - 35 USC § 102

Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizusawa, 4,644,614.

Regarding claim 4, Mizusawa discloses, in Figure 9, a novelty system comprising a body **C**, one or more appendages **P**, and a connecting structure **27**. The body **C** has apertures **C1**. The appendages **P** correspond to the apertures **C1**. Each of the appendages **P** includes at least one connecting member **21**. The connecting structure **27** comprises a post **28a** with prongs **28b,28c** flexibly coupled to the first end of the post **28a**. The prongs **28b,28c** extend toward the body **C**.

Applicants should note that the connecting structure **27** secures the appendages **P** to the body **C**.

Regarding claim 5, the appendages **P** comprise a wing structure.

Regarding claim 6, the connecting structure **27** includes a second end **26** configured to connect to the one or more appendages **P**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs 4,973,212 (see marked-up attachment), in view of Moore et al., 5,716,161.

Regarding claim 4, Jacob discloses, in Figure 4, a novelty system comprising a body **86**, one or more appendages **88**, and a connecting structure **68**. The body **86** has apertures **84**. The appendages **88** correspond to the apertures **84**. Each of the appendages **88** includes at least one connecting member **110**. The connecting structure **68** comprises a post **70** with prongs **72,74** flexibly coupled to a first end **A2** of the post **70**. However, Jacobs fails to disclose the prongs **72,74** extending toward the body **86**. Moore et al. teach, in Figure 6, prongs **70, 72** extending toward a body **15** as an alternative design consideration for mounting a connecting structure to the body. Therefore, as taught by Moore et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to design the prongs so that the prongs extend toward the body as an alternative design consideration to mount a connecting structure to the body.

Applicants should note that the connecting structure **68** secures the appendages **88** to the body **86**.

Regarding claim 5, the appendages **88** comprise a wing structure.

Regarding claim 6, the connecting structure **68** includes a second end **A12** configured to connect to the one or more appendages **88**.

Regarding claim 7, the one or more appendages **88** comprises an enclosure **90** configured to secure the second end **A12** of the connecting structure **68**.

Regarding claim 8, the connecting structure **68** is a coil spring (col. 5, lines 38-44).

Regarding claim 9, the connecting structure **68** has a spring constant that allows the appendages **88** to be freely movable with respect to the body **86** responsive to wind actuation.

Regarding claim 10, applicants are reminded that in method claims, it is the patentability of the method steps that is to be determined and not the recited structure. Structure not affected in the manipulation sense is given no patentable weight. Further, given the structure of Jacobs as modified by Moore et al., the method of constructing a novelty is inherently performed. Therefore, Jacobs discloses the method comprising:

secure appendages **88** by operatively connecting connecting structures **68** with apertures **84** of a body **86** (the novelty); and,

position thereby prongs **72,74** flexibly coupled to a first end of each of the connecting structures **68**. However, Jacob, as modified by Moore et al., fail to teach

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shipping, in at least partially unassembled manner, the body **86** (the novelty) and unpacking the novelty (col. 1, lines 10-15).

Applicants are reminded that shipping and unpacking are secondary steps in delivering the invention to a customer whom purchases the invention. The shipper normally ships the invention in at least partially unassembled manner or in a fully assembled manner, and upon delivery, the customer will unpack the invention from bubble wrap, popcorn, newspaper, or paper wrap. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ship the novelty, in at least partially unassembled manner, and unpack the novelty as part of a delivery process.

Regarding claim 11, the step of securing includes inserting the connecting structures **68** into the apertures **84**.

Response to Arguments

Applicants' arguments with respect to claims 4-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. In particular, the added limitations "each said appendage including at least one flexible connecting member" recited in lines 5-6 of claim 4, and "said prongs extending towards said body to terminate at respective termini" recited in lines 11-12 of claim 4, "in at least partially unassembled manner" recited in 2 of claim 10, and "positioning thereby a plurality of prongs flexibly coupled to a first end of each said connecting structure to extend towards said body, said prongs terminating at respective termini for engaging said body" recited in lines 10-12 of claim 10 necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30-5:30. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

June 14, 2005

Attachment: one marked-up page of Jacobs, 4,973,212.



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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(Jacobs) 4,973,212

